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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,288	11/13/2001	Frans Gerrit Davelaar	AHP-98249	5326
25291	7590	08/01/2005	EXAMINER	
			FOLEY, SHANON A	
		ART UNIT		PAPER NUMBER
				1648

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.	10/054,288	Applicant(s) DAVELAAR, FRANS GERRIT
Examiner Shanon Foley	Art Unit 1648	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 21 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1.  The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
  - a)  The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
  - b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2.  The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3.  The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
  - (a)  They raise new issues that would require further consideration and/or search (see NOTE below);
  - (b)  They raise the issue of new matter (see NOTE below);
  - (c)  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d)  They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4.  The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7.  For purposes of appeal, the proposed amendment(s): a)  will not be entered, or b)  will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See the attached correspondence.
12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.
13.  Other: \_\_\_\_\_.

  
 Shanon Foley  
 Primary Examiner  
 Art Unit: 1648

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-15, 17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Poston et al. (WO 99/53950) for reasons of record.

### ***Claim Rejections - 35 USC § 102***

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 16 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Poston et al., *supra* for reasons of record.

Claims 2 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Poston et al. as applied to claims 1, 3-9, 15, 17 and 18 above, and further in view of Ricks et al. (*Advances in Veterinary Medicine*. 1999; 41: 495-515, provided in the IDS) for reasons of record.

***Response to Arguments***

Applicant submits that the transitional phrase “consisting essentially of” is not equivalent to “comprising” under the circumstances in the case and sufficiently distinguishes over the prior art. Applicant parallels the facts in this case with the facts of *PPG Industries v. Guardian Industries*, 156 F.3d, 48 USPQ2d 1351 (Fed. Cir. 1998), which discusses whether an unlisted ingredient was excluded from the claimed scope of “consisting essentially of”. Applicant asserts that the instant specification and prosecution make it clear that the unlisted ingredient of interferon is excluded from the claims since interferon is not discussed in any way.

Applicant’s arguments have been fully considered, but are not found to be persuasive. In the case discussed by applicant, the Federal Circuit limited PPG to what was taught in the specification. In PPG’s disclosure, reference to SO<sub>3</sub> was used in the context of a melting and fining aid. This teaching provided the court with inference as to the types of compounds used and their functions encompassed by the invention. PPG attempted to specifically exclude the iron sulfide used by Guardian in view of this mention of SO<sub>3</sub> in the disclosure. However, the court concluded that this mention did not include different sulfur compounds, such as those used by the alleged infringer, Guardian Industries Corp. This set of scenarios differs from the facts in the instant case because unlike PPG, the instant disclosure does not mention IL-2 or any element analogous to it. Therefore, the instant specification provides no guidance or inference as to what classes of compounds are intended to be excluded from the transitional phrase “consisting essentially of”.

Another analysis made by the court in the PPG case was whether the unlisted iron sulfide used by Guardian had a material effect on the “green tinted, ultraviolet absorbing glass” of PPG.

The court found that the iron sulfide did in fact result in a change in total light transmittance by 0.5% and a small change in color, see page 1353. In the instant case, the IL-2 of Poston et al. 1) protects poultry from pathology that would occur in the absence of INF and 2) induces a protective immune response to the vaccine, see page 3, lines 6-9. In other words, the INF of Poston et al. has no material effect on the virus composition, but on the immune system it is administered to. The INF of Poston et al. does not affect the virus co-administered with the live, pathogenic virus, i.e. the composition instantly claimed. For this reason, it is determined that the transitional phrase "consisting essentially of"...."includes listed ingredients and is open to unlisted ingredients that do not materially affect basic and novel properties of invention", see page § 125.1305 on page 1351 of PPG v. Guardian. Unlisted ingredients or the absence of discussion of an ingredient does not suffice to exclude the ingredient from a composition that is not materially affected by the ingredient. For these reasons, it is maintained that the invention does not define over the prior art cited.

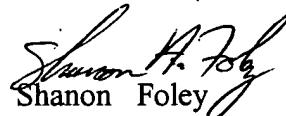
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanon Foley whose telephone number is (571) 272-0898. The examiner can normally be reached on M-F 6:00 AM - 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (571) 272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Shanon Foley  
Primary Examiner  
Art Unit 1648